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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,531	01/26/2001	Naohito Takae	1095.1155 (JDH)	4909

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WASHINGTON, DC 20005

EXAMINER
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CHOW, MING

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 04/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

*Am*

**Office Action Summary**

Application No.

09/769,531

Applicant(s)

TAKAE ET AL.

Examiner

Ming Chow

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Objections***

1. Claim 13 recites "the other mobile telephony devices". There is insufficient antecedent basis for this limitation in the claim.
2. Claim 14 recites "the mobile telephony devices" and "the respective update". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "a telephone number changing a telephone number" is not clearly defined. The Examiner cannot understand the meaning of this limitation. Also, the phrase "the extracted registrants" is not clearly defined. It is unclear if the "extracted registrant" is the same as previously claimed "a registrant" in claim 1.

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4. Claims 14, 15 are is rejected under 35 U.S.C. 112, second paragraph, as each claim depends on itself respectively. The Examiner reads claims 14 and 15 to be “A method according to claim 13,.....”

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-5, 7, 8, 10-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Keiko et al (JP: 2001-245050).

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For claims 1, 7, 11, Keiko et al teach on Fig. 1-3 and paragraph 20-34 telephone number changing means to change a number in response to a request to a telephone directory of a registrant who's phone number has been registered in the phone number changer's directory.

Regarding "a telephone number changing a telephone number.....the number changer", Keiko et al teach on paragraph 23-26 and Fig. 6 extracting registrants information for sending a change notification. Keiko et al teach on paragraph 26-36 notifying registrants of number change and modify the number changer's telephone number in registrant's telephone directory.

Regarding claims 2, 3, 15, all rejections as stated in claim 1 above apply.

Keiko et al teach on paragraph 23-26 and Fig. 6 extracting registrants information for sending a change notification.

Regarding claims 4, 5, Keiko et al teach on Fig. 17 means for confirming in advance before modification.

Regarding claim 8, Keiko et al teach on paragraph 26 the step 6 of Fig. 3 generating the change notification by item 5 of Fig.1 (claimed "portable telephone service provider").

Regarding claim 10, Keiko et al teach on Fig. 8 means for reflecting telephone number difference.

Regarding claim 12, all rejections as stated in claims 1-5, 7, 8, 10, 11 above apply.

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Regarding claims 13, 14, all rejections as stated in claim 1 above apply.

Regarding “central data center”, Keiko et al teach on paragraph 17 data-storage section (claimed “central data center”) where maintains the telephone directory.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keiko et al as applied in claim 1 above, and in view of Kyu (JP: 411331353). Keiko et al failed to teach “specify a time at which the telephone number change is to be performed”. However, Kyu teaches on Abstract – a schedule table (reads on claimed “specify a time”) for editing telephone directory. It would have been obvious to one skilled at the time the invention was made to modify Keiko et al to have the “specify a time at which the telephone number change is to be performed” as taught by Kyu such that the modified system of Keiko et al would be able to support the specifying a time for changing the telephone number to the system users.

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7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keiko et al as applied in claim 8 above, and in view of Lautenschlager et al (US: 6289091). Keiko et al failed to teach “said telephone.....service provider”. However, Lautenschlager et al teach on Abstract – the directory number administration (reads on claimed “telephone service provider”) issues the change order and synchronizes the changes to the subscriber terminal (claimed “number changer”). It would have been obvious to one skilled at the time the invention was made to modify Keiko et al to have the “said telephone.....service provider” as taught by Lautenschlager et al such that the modified system of Keiko et al would be able to support the notification instruction from the service provider to the system users.

***Response to Arguments***

8. Applicant's arguments filed on 1/12/04 have been fully considered but they are not persuasive.

- i) Applicant argues, on pages 6-8, regarding referenced prior arts relative to the amendments. New grounds of rejections necessiated by the amendments have been stated above.

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*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:



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**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

**Or faxed to Central FAX Number 703-872-9306.**

Patent Examiner

Art Unit 2645

Ming Chow



**FAN TSANG**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**

